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	First Named Inventor	G. Victor Treyz
	Art Unit	3625
	Examiner Name	Cuong H. Nguyen
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

SVT-1

#15  
3/19/04

Applicants : G. Victor Treyz et al.  
Application No. : 09/365,651  
Confirmation No. : 2056  
Filed : August 2, 1999  
For : ON-LINE IMAGE SYSTEM  
Group Art Unit : 3625  
Examiner : Cuong H. Nguyen

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AMENDED APPEAL BRIEF

Sir:

Applicants filed the original version of this appeal brief on November 24, 2003 pursuant to 37 C.F.R. § 1.192 in support of their appeal from the final rejection of claims 21-40 in the Office Action dated August 25, 2003.

On February 24, 2004, the Patent Office mailed applicants a "Notice of Non-Compliance With 37 C.F.R. §1.192(c)" stating that applicants' invention summary did not comply with 37 C.F.R. §1.192 because it did not contain sufficient references to the specification by page and line number and to

the drawings by reference characters. Applicants are therefore submitting this Amended Appeal Brief (in triplicate). The Amended Appeal Brief contains a summary section which references the specification by page and line number and references the drawings by reference characters. The Amended Appeal Brief complies with 37 C.F.R. §1.192. If any fees are due in connection with this submission, the Commissioner is hereby authorized to charge those fees to Deposit Account No. 502942.

#### Introduction

Claims 21-40 were finally rejected in an Office Action dated August 25, 2003. The rejections of claims 21 and 23-40 are obviousness rejections based on Oberg U.S. patent 5,870,771 ("Oberg") and Nozaki U.S. patent 6,349,194 ("Nozaki") or Oberg and an article in the Patriot Ledger by Melissa Weisman entitled "Internet Wedding Albums Reach Far-Flung Relatives" ("Weisman"). The rejections of claim 22 are obviousness rejections based on Oberg, Nozaki, and Plettinck U.S. patent 5,870,771 ("Plettinck") or Oberg, Weisman, and Plettinck. For the reasons set forth below, the Board should find these rejections to be in error and should reverse the Examiner. A copy of claims 21-40 is attached as an Appendix.

### Real Party In Interest

The real party in interest is the party identified in the caption of this Appeal Brief.

### Related Appeals and Interferences

There are no other appeals or interferences known to applicants or their legal representative that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### Status of Claims

Claims 21-40 are pending in this application and are on appeal.

### Status of Amendments

No amendments have been filed subsequent to the August 25, 2003 final Office Action in this case.

### Summary of the Invention

Applicants' invention relates to various aspects of on-line image systems.

One aspect of the invention relates to order servicing equipment for an on-line system that allows a user to order image-based products over the Internet. The order servicing

equipment has a computer that receives uploaded digital images over the Internet. The order servicing equipment also has digital printing equipment that prints edited digital images to create prints for framing. The order servicing equipment is configured to present the user with an opportunity to select a given type of frame for a print that has been printed by the digital printing equipment. This aspect of the invention is set forth in claims 21, 23-26, and 28-30.

The order servicing equipment is shown at reference number 16 in FIG. 1 and at reference number 16 in FIG. 5 and is described generally at page 2, line 31 to page 3, line 7 and page 3, line 25 to page 4, line 3 and page 4, line 36 to page 5, line 10. The capability of the order servicing equipment to handle uploaded digital images over the Internet is discussed generally at page 3, lines 3-5. FIG. 5 shows the computer 46 in the order servicing equipment that receives uploaded digital images over the Internet (communications network 18). The use of the order servicing equipment 16 to receive uploaded images and to use digital printing equipment 48 to print the images is described at page 17, lines 10-12 and at page 19, line 27 to page 20, line 13. A web page that may be used to upload images to the order servicing equipment is shown in FIG. 25 and is described at page 38, line 20 to page 39, line 8. Step 76 of FIG. 78 shows the process of uploading images to the order

servicing equipment. The process of uploading images of step 76 is discussed at page 20, lines 23-32. Image editing options with which images are edited are shown in FIG. 34 (e.g., color 492, contrast 494, sharpness 496, backgrounds 498, other 500, and cropping options 510, 512, 514, and 516) and are discussed at page 48, line 7 to page 49, line 4.

The ability of the order servicing equipment to allow a customer to order image-based products over the Internet is discussed generally at page 3, lines 22-26. Some of the image-based products that may be ordered are shown on the web page of FIG. 29 (e.g., mouse pads and framed prints). These ordering options are described at page 42, line 29 to page 43, line 5 and page 45, lines 8-12. The ability to use the order servicing equipment to select which type of frame is to be used for a framed print is described at page 49, lines 13-19.

FIGS. 35, 37, and 38 also show these features. The uploading process is shown at step 522 of FIG. 35 (page 49, lines 11-13). The editing of the uploaded images is shown at step 524 of FIG. 35 (page 49, lines 13-21) and step 586 of FIG. 38 (page 53, line 23 to page 54, line 17). Image presentation options such as album material or frame type may then be selected (see, e.g., the album material selection web page in FIG. 37 and page 51, line 34 to page 52, line 1). The step of selecting which types of materials are used in framed

photographs is shown at step 588 and 590 in FIG. 38 (page 54, lines 18-26). As described at page 52, lines 33-35, "[t]he photographer may be presented with an opportunity to select the frame type (e.g., wood, metal), frame color ...."

Another aspect of the invention relates to an on-line system for ordering albums of different materials. This aspect of the invention is covered in claim 27.

The selection of different materials for albums is shown in web page 568 of FIG. 37 and is described at page 51, line 34 to page 52, line 9. The selection of different album types is also shown in step 590 of FIG. 38 (page 54, lines 18-22). On-line ordering is described, e.g., in connection with steps 526 and 528 in FIG. 35 at page 49, lines 21-30.

The invention also relates to email messages that include URLs that allow recipients to view and order prints through a web browser. See claim 31.

A description of this feature is provided at page 3, lines 13-24. An illustrative email notification message having a URL 394 is shown in FIG. 26 and is described at page 40, lines 13-32.

As set forth in claim 32, applicants' invention also relates to ordering prints that include the user as a subject and that include a background different than the background against which the user was originally photographed.

This feature is described at page 5, lines 3-10 and at page 53, line 33 to page 54, line 17 and is shown at step 586 of FIG. 38.

With the order servicing equipment defined by claims 33, 35-37, and 40, users can place on-line orders for prints of digital images taken by a photographer at an event. The order servicing equipment includes an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The order servicing computer uses the customer information in providing customers with an opportunity to place an on-line order for a print.

A description of event photography is provided at page 13, lines 1-6. Processes for providing the customer list to the order servicing computer are described at page 35, line 15 to page 37, line 7. Page 324 of FIG. 20 may be used to specify the location of the customer list or to choose to enter customer information manually, etc. FIG. 25 shows the use of assignment title that identifies an event (the "Smith Wedding") in region 380 (page 38, lines 26 and 27). Assignment titles may be



entered using field 318 of FIG. 19 (see page 34, line 29 to page 35, line 14). One way in which the customer information may be used is by placing school photographs on a web site and notifying the students whose photographs are available (page 15, lines 6-13).

The invention also relates to systems in which customers are originally photographed against a solid background. The resulting digital image can then be manipulated to replace the solid color background with a new background. (See claims 34 and 39.)

This feature is described at page 5, lines 3-10 and at page 53, line 33 to page 54, line 17 and is shown at step 586 of FIG. 38.

Claim 38 is directed to features of the invention that relate to ordering wood and metal framed prints of images taken by a photographer at an event.

A description of how a photographer may take images at an event is provided at page 13, lines 1-6. The creation of prints from images is described in connection with printing equipment 42 (FIG. 1) and 48 (FIG. 5) (see page 17, lines 5-16). As described at page 52, lines 33-35, "[t]he photographer may be presented with an opportunity to select the frame type (e.g.,

wood, metal), frame color ...." for the prints. On-line ordering of prints is described, e.g., at page 49, lines 21-30 in connection with steps 526 and 528 in FIG. 35.

As set forth in more detail below, the prior art does not show or suggest the features of applicants' claims.

#### Issues on Appeal

The following issues are to be reviewed on this appeal:

1. Whether claims 21-26 and 28-30, which relate to equipment that prints edited digital images to create prints for framing is obvious from Oberg in various combinations with Nozaki, Weisman, and Plettinck, despite the fact that the Oberg system that was relied upon in rejecting these claims does not create prints for framing.

2. Whether claim 27, which relates to ordering of albums of different materials, is obvious from Oberg in combination with Nozaki or Weisman, even though the Oberg abstract that was relied upon in rejecting claim 27 makes no mention of albums of different materials.

3. Whether claim 31, which relates to using email messages that include URLs to allow recipients to view and order prints through a web browser, is obvious from Oberg in

combination with Nozaki or Weisman, even though the Oberg, Nozaki, and Weisman references do not have email messages that include URLs that allow a message recipient to view and order prints through a web browser.

4. Whether claim 32, which is directed to ordering prints that include the user as a subject and that include a background different than the background against which the user was originally photographed, are obvious from Oberg in combination with Nozaki or Weisman, even though the Weisman reference that was relied upon in rejecting claim 32 does not even mention what backgrounds could be used when photographing a user.

5. Whether claims 33, 35-37, and 40, which are directed to an order servicing computer that is provided with a customer list and that uses an assignment title to identify a photographed event, are obvious from Oberg and Nozaki or Oberg and Weisman, even though nothing in Oberg, Weisman, and Nozaki relates to order servicing computers for event photography having customer list or assignment title capabilities.

6. Whether claims 34 and 39, which are directed to photographing customers against a solid color background and manipulating the resulting digital image to replace the solid color background with a new background, are obvious from Oberg in combination with Nozaki or Weisman, even though Oberg,

Nozaki, and Weisman do not disclose replacing backgrounds in images.

7. Whether claim 38, which relates to ordering wood and metal framed prints of images taken by the photographer at an event, is obvious from Oberg, Weisman, or Nozaki even though nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal framed prints.

#### Grouping of Claims

For the purposes of this appeal, the claims may be considered to stand or fall in the following groups:

Group 1: Claims 21-26 and 28-30. Claim 21 is directed to order servicing equipment for an on-line system that allows a user to order image-based products over the Internet. The order servicing equipment has a computer that receives uploaded digital images over the Internet. The order servicing equipment also has digital printing equipment that prints edited digital images to create prints for framing. The order servicing equipment is configured to present the user with an opportunity to select a given type of frame for a print that has been printed by the digital printing equipment. Dependent claims 22-26 and 28-30 stand or fall with claim 21.

Group 2: Claim 27. Claim 27 depends from claim 21 and adds the further limitations that the order servicing computer is configured to provide the user with an on-line opportunity to order frames of different colors and is configured to provide the user with an on-line opportunity to order albums of different materials. Claim 27 is separately patentable from claim 21, because the prior art does not show or suggest that order servicing equipment having the ability to handle albums of different materials should be included in a system in which a user uploads images, edits the uploaded images, prints the edited images, and orders frames for the printed edited images.

Group 3: Claim 31. Claim 31 depends from claim 21 and adds the further limitations that the order servicing computer is configured to e-mail a message to a party other than the user over the Internet. The message includes a URL that allows the party to view and order prints of the edited digital image on-line using a web browser. Claim 31 is separately patentable from claim 21, because the prior art does not show or suggest that order servicing equipment that sends email messages containing URL's that allow parties to view and order prints should be included in a system in which a user uploads images,

edits the uploaded images, prints the edited images, and orders frames for the printed edited images.

Group 4: Claim 32. Claim 32 depends from claim 21 and adds the further limitations that the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject and that includes a background different than the background against which the user was originally photographed. Claim 32 is separately patentable from claim 21, because the prior art does not show or suggest that order servicing equipment that is used to order prints of digital images that include the user as a subject and a background different than the background against which the user was originally photographed should be included in a system in which a user uploads images, edits the uploaded images, prints the edited images, and orders frames for the printed edited images.

Group 5: Claims 33, 35-37, and 40. Claim 33 is directed toward order servicing equipment that allows users to place on-line orders for prints of digital images taken by a photographer at an event. The order servicing equipment has an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The

order servicing computer uses the customer information in providing customers with an opportunity to place an on-line order for a print. Dependent claims 35-37 and 40 stand or fall with claim 21.

Group 6: Claims 34 and 39. Claims 34 and 39 depend from claim 32 and add further limitations relating to servicing orders for prints where customers are originally photographed against a solid background. The resulting digital image is then manipulated to replace the solid color background with a new background. Claims 34 and 39 are separately patentable from claim 32, because the prior art does not show or suggest that order servicing equipment that is used to order prints of digital images where customers are originally photographed against a solid background and then have that image manipulated digitally to replace the solid background should be included in a system in which on-line orders are placed for prints of digital images taken by a photographer at an event.

Group 7: Claim 38. Claim 38 depends from claim 32 and adds further limitations relating to servicing orders for wood and metal framed prints of images taken by the photographer at the event. Claim 38 is separately patentable from claim 32, because the prior art does not show or suggest that order

servicing equipment that is used to service orders for wood and metal framed prints of images taken by the photographer at the event should be included in a system in which on-line orders are placed for prints of digital images taken by a photographer at an event.

#### Argument

A. The Rejection of Claims 21-26 and 28-30  
(The Group 1 Claims)  
Under 35 U.S.C. § 103(a)

In the August 25, 2003 Office Action, claims 21, 23-26 and 28-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman. Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman in further view of Plettinck. These rejections are improper and should be reversed.

Independent claim 21 is directed to order servicing equipment for an on-line system that allows a user to order image-based products over the Internet. The order servicing equipment has a computer that receives uploaded digital images over the Internet. The order servicing equipment also has digital printing equipment that prints edited digital images to create prints for framing. The order servicing equipment is



configured to present the user with an opportunity to select a given type of frame for a print that has been printed by the digital printing equipment.

Oberg describes a computer system that helps users select frames for their artwork. The system combines images of the user's artwork with images of frames and allows the user to preview a combined image on a display screen before ordering a given frame. The Oberg patent is directed primarily to systems that are located in a store, although Oberg mentions in passing that customers "will also have access to the software via the Internet which will allows them to make their selections, place orders, and make payment from their home." (See column 7 lines 22-33 of Oberg.)

In general, a user of the Oberg system brings artwork to the store in order to purchase a frame. In the store, the user can use the Oberg system to help generate a preview. Oberg's system is not designed for ordering prints of digital images on-line. At column 7, lines 9-13, Oberg says that "A print command is available to acquire one or more copies of the finished framed order including an image of the order, the bill of material, and the total order cost." Oberg's system can therefore generate order copies, not prints to be framed.

In the final Office Action, the Examiner suggested that Oberg's system is capable of performing the operations

performed by the system of claim 21. Applicants disagree. Oberg's system does not have the necessary hardware and software to produce prints to be framed and nothing in Oberg describes the production of prints to be framed. As a result, Oberg's system cannot and does not produce prints to be framed. The hardware and software of the Oberg system produces order copies.

Applicants' order servicing equipment is able to service orders for digital photographic prints and frames for those prints. After a user has uploaded a digital image to the order servicing computer, applicants' digital printing equipment prints that image to create a print for framing. The user is presented with an opportunity to select a given type of frame for that print. This arrangement is explicitly set forth in claim 21. In particular, claim 21 requires that applicants' order servicing equipment have digital printing equipment that prints digital images to create a print for framing.

Oberg's system works differently. The Oberg system does not create a print for framing. This is because the user in Oberg already has the original artwork that is to be framed in their home. Although Oberg's system prints a confirmation copy of the user's order, there is no reason that the user would frame that order confirmation. The information that is printed in Oberg includes order information such as the bill of material and the total order cost -- clearly not information that is

suitable for framing.

The Nozaki and Weisman references fail to make up for the deficiencies in Oberg.

Nozaki relates to a system for generating sound images. The Nozaki patent contains the term "frame." However, Nozaki makes it clear that this term is not being used with its normal meaning. The Nozaki "frames" are not ordinary physical picture frames for hanging on a wall, but are graphic constructs that are used as templates. (See, for example, column 13, lines 32-34, where Nozaki explicitly defines the term "frame" as meaning the "image recording region" in which an image is recorded.) Weisman also fails to disclose frames. Because neither Nozaki or Weisman disclose picture frame ordering capabilities, it is not surprising that neither of these references make up for the failure of Oberg's system to provide a user an opportunity to order a frame for framing the print created by the digital printer.

Claim 21 is therefore patentable over Oberg, whether or not Oberg is combined with the Nozaki and Weisman references as proposed. Claims 23-26 and 28-30 depend from claim 21 and are patentable because claim 21 is patentable.

B. The Rejection of Claim 27 Under 35 U.S.C. § 103(a)

In the August 25, 2003 Office Action, the Group 2 claim (claim 27) was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman. These rejections are improper and should be reversed.

Claim 27 is directed to the feature of applicants' invention that allows ordering of albums of different materials. In the Office Action, reference was made to Oberg's abstract in rejecting claim 27. However, the Oberg abstract makes no mention of albums of different materials, let alone on-line ordering of albums of different materials.

In the final Office Action, it was stated that "a selection from user would imply that there are different materials to choose" (citing the Oberg Abstract). It was also stated that the Oberg "does not necessarily spell-out similar languages because one with ordinary skill in the art would know and understand about the equivalent (although different) meanings of this invention." (Final Office Action, page 1).

Applicants maintain their original position: Oberg's abstract makes no mention of albums of different materials or the ordering of albums of different materials. The reason Oberg does not "spell-out" anything to do with albums is because Oberg's system is directed to a different endeavor -- namely the

computerized previewing of artwork in a store, not the on-line selection of albums. There is nothing in Oberg that even suggests that the Oberg artwork would be suitable to fit in an album in the first place.

The Oberg system clearly relates to artwork to be framed, not artwork to be placed in an album. Because claim 27 explicitly requires the ordering of albums of different materials, whereas Oberg does not show or suggest albums of any sort, claim 27 is patentable.

C. The Rejection of Claim 31 Under 35 U.S.C. § 103(a)

In the August 25, 2003 Office Action, the Group 3 claim (claim 31) was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman. These rejections are improper and should be reversed.

Claim 31 is directed to using email messages that include URLs that allow recipients to view and order prints through a web browser. Claim 31 was rejected with reference to Weisman and Oberg's summary. However, neither Weisman or Oberg disclose email messages that include URLs that allow a message recipient to view and order prints through a web browser.

In addressing these shortcomings of Weisman and Oberg in the final Office Action (page 2, item 3C), it was stated that

"one with ordinary skill in the art would recognize that an email message may include a service provider's URL; because an email would contain many different things" and that one of these things "can be a service provider's website because this create a convenience for email receiver who likes to communicate with said service provider."

This is not sufficient for a §103 rejection. A §103 rejection must be based on the prior art, not hindsight reconstruction based on applicants' own invention. Even though an email might contain different things, it does not follow that prior art emails included applicants' claimed URLs as intimated in the final Office Action. There is simply nothing in the Oberg, Weisman, or Nozaki cited prior art to suggest providing email messages containing URLs to message recipients so that the recipients can view and order prints through a web browser as set forth in claim 31.

Claim 31 is therefore patentable over Oberg, Weisman, and Nozaki.

D. The Rejection of Claim 32 Under 35 U.S.C. § 103(a)

In the August 25, 2003 Office Action, the Group 4 claim (claim 32) was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the

combination of Oberg and Weisman. These rejections are improper and should be reversed.

Claim 32 is directed to ordering prints that include the user as a subject and that include a background different than the background against which the user was originally photographed. claim 32 was rejected with reference to Weisman. Weisman mentions backgrounds, but they are not the type of backgrounds that are inside a picture. Rather, Weisman's "backgrounds" are the colors of the web pages on which the Memories Online web site displays clients' images. Because the Memories Online web page colors are not part of the image, Weisman does not disclose the feature of claim 32 wherein the user can order prints that include both the user as a subject and a background different than the background against which the user was originally photographed. The Memories Online background colors do not take the place of the background against which the user was originally photographed.

In addressing these points in the final Office Action, it was stated that "different background (e.g., a black background or a white background for a picture does not make it inventive)." (Final Office action page 2). In making this statement, the final Office Action appears only to have focused on the word "background" and has not addressed the explicit language in claim 32 that specifies how the background is one

that is "different than the background against which the user was originally photographed." Because the Memories Online web site on which this rejection was based makes no mention of applicants' background replacement feature, claim 32 is patentable.

E. The Rejection of Claims 33, 35-37, and 40  
Under 35 U.S.C. § 103(a)

In the August 25, 2003 Office Action, the Group 5 claims (claims 33, 35-37, and 40) were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman. These rejections are improper and should be reversed.

Independent claim 33 relates to event photography. In particular, claim 33 is directed toward order servicing equipment that allows users to place on-line orders for prints of digital images taken by a photographer at an event. As set forth in claim 33, the order servicing equipment comprises an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The order servicing computer uses the customer information in providing customers with an opportunity to place an on-line order for a print.

Nothing in Oberg, Weisman, and Nozaki relates to on-



line systems for event photography having the customer list and assignment title features of claim 33.

In the final Office Action, the shortcomings of Oberg, Weisman, and Nozaki with respect to event photography were addressed by stating that the "claimed language 'customer list' and 'title' in a provider's database are old and well-known in the art." (Final Office Action, page 2, item 3E)

However, it doesn't follow that because a customer list or a title is "old," that it would be obvious to produce order servicing equipment that allows users to place on-line orders for prints of digital images taken by a photographer at an event that has an order servicing computer that is provided with a customer list and that uses an assignment title to identify the event. The shortcomings of Oberg, Weisman, and Nozaki that applicants have identified with respect to computerized on-line event photography are not made up for by the fact that customer lists and titles are old.

Claim 33 is therefore patentable over Oberg, Weisman, and Nozaki. Claims 35-37 and 40 depend from claim 33 and are patentable because claim 33 is patentable.

F. The Rejection of Claims 34 and 39 Under 35 U.S.C. § 103(a)

In the August 25, 2003 Office Action, the Group 6 claims (claims 34 and 39) were rejected under 35 U.S.C. § 103(a)

as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman. These rejections are improper and should be reversed.

Claims 34 and 39 are directed to arrangements in which customers are originally photographed against a solid background. The resulting digital image is then manipulated to replace the solid color background with a new background. The Oberg, Weisman, and Nozaki references do not disclose this feature. The "backgrounds" of Weisman that were relied upon in rejecting these claims are just the colors of the web pages on which the Memories Online website displays images.

Claims 34 and 39 are therefore patentable over Oberg, Weisman, and Nozaki.

G. The Rejection of Claim 38 Under 35 U.S.C. § 103(a)

In the August 25, 2003 Office Action, the Group 7 claim (claim 38) was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Oberg and Nozaki or the combination of Oberg and Weisman. These rejections are improper and should be reversed.

Claim 38 relates to ordering wood and metal framed prints of images taken by a photographer at an event. Nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal framed prints, let alone the ordering

of wood or metal framed prints of images taken by a photographer at an event.

In item 3G of the final Office Action it is implied that claim 38 isn't patentable because wood frames are old. However, it simply does not follow that the arrangement of claim 38 that allows the ordering of wood and metal framed prints of images taken by the photographer at an event is unpatentable because wood frames are old. The fact that wood frames are old does not make up for the deficiencies in the Oberg, Weisman, and Nozaki references.

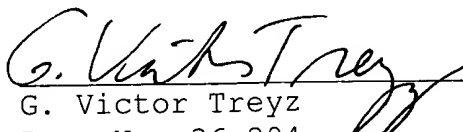
Because nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal framed prints of images taken by a photographer at an event, claim 38 is patentable.

#### Conclusion

For the reasons set forth above, claims 21-40 are in condition for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,

3/12/04  
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## APPENDIX

### CLAIMS ON APPEAL

21. Order servicing equipment for an on-line system that allows a user to order image-based products over the Internet, comprising:

at least one order servicing computer that receives an uploaded digital image over the Internet; and  
digital printing equipment, wherein the order servicing computer is configured to present the user with an opportunity to view the uploaded digital image on-line over the Internet, wherein the order servicing computer is configured to provide the user with an opportunity to edit the uploaded digital image on-line over the Internet, wherein the digital printing equipment is configured to print the edited digital image to create a print for framing, and wherein the order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print.

22. The order servicing equipment defined in claim 21 wherein the print is framed using the selected frame after the user places an order, and wherein the order servicing equipment further comprises packaging equipment that is used in packaging the framed print that the user ordered for mailing.

23. The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to allow the user to crop the uploaded digital image on-line.

24. The order servicing equipment defined in claim 23 wherein the order servicing computer is configured to provide the user with an opportunity to set up an account at the order servicing equipment by providing a name, e-mail address, and password and is configured to provide the user with an opportunity to provide text associated with the uploaded digital image using the Internet.

25. The order servicing equipment defined in claim 23 wherein the order servicing computer is configured to allow the user to change the uploaded digital image from color to black-and-white during editing on-line.

26. The order servicing equipment defined in claim 25 wherein the order servicing computer is configured to allow the user to change the uploaded digital image contrast during editing on-line.

27. The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to provide

the user with an on-line opportunity to order frames of different colors and is configured to provide the user with an on-line opportunity to order albums of different materials.

28. The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to allow the user to add audio to the uploaded digital image over the Internet.

29. The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to provide the user with an on-line opportunity to select from frames of different colors and mats of different colors and is configured to provide the user with an on-line opportunity to order a framed print of the digital image, wherein the framed print uses the selected frame and the selected mat.

30. The order servicing equipment defined in claim 29 wherein the order servicing computer is configured to provide the user with an on-line opportunity to select from different mat styles, wherein the framed print uses the selected mat style.

31. The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to e-mail a message to a party other than the user over the Internet, wherein the message includes a URL that allows the party to view and order prints of the edited digital image on-line using a web browser.

32. The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject and that includes a background different than the background against which the user was originally photographed.

33. Order servicing equipment that allows customers to place on-line orders for prints of digital images taken by a photographer at an event, comprising:

at least one order servicing computer, wherein the order servicing computer is provided with the digital images taken by the photographer and is provided with customer information including a customer list that includes names of the customers for the event, wherein the order servicing computer uses an assignment title to identify the event, wherein the order servicing computer is configured to provide the customers

with an on-line opportunity to select the given event from a list of events, wherein in at least some of the digital images a customer in the customer list is a subject of the digital image, wherein the order servicing computer is configured to use the customer information in providing each of the customers with an opportunity to place an on-line order for a print of at least one of the digital images to be mailed to the customer.

34. The order servicing equipment defined in claim 33 wherein at least one of the customers was originally photographed against a solid color background to produce a digital image and wherein that digital image was manipulated to replace the solid color background with a new background, and wherein a print of the digital image that includes the customer with the new background is provided for on-line ordering by the customer over the Internet.

35. The order servicing equipment defined in claim 33 wherein the order servicing computer is configured to provide each of the customers with an on-line opportunity to select a frame and to order a print of one of the digital images in the selected frame.



36. The order servicing equipment defined in claim 33 wherein the order servicing computer is configured to allow the customers to crop the digital images on-line before placing orders for the digital images.

37. The order servicing equipment defined in claim 33 wherein the order servicing computer is configured to provide opportunities for on-line customer editing of the digital images, wherein the order servicing computer is configured to provide the customers with on-line opportunities to order framed prints of the digital images, wherein the order servicing computer is configured to provide the customers with on-line opportunities to order prints of digital images of customers in which original backgrounds have been replaced by new backgrounds, and wherein the new backgrounds contain images of people.

38. Order servicing equipment that allows customers to place on-line orders for prints of digital images taken by a photographer at an event, wherein at least some of the digital images include the customers, comprising:

at least one order servicing computer, wherein the order servicing computer is provided with the digital images taken by the photographer and is provided with customer

information identifying at least some of the customer in the digital images, wherein the order servicing computer is configured to allow the customers to view the digital images over the Internet using a web browser, wherein the order servicing computer is configured to provide the customers with opportunities to order wood and metal framed prints of the digital images over the Internet.

39. The order servicing equipment defined in claim 38 wherein at least one of the customers was originally photographed against a solid color background to produce a digital image and wherein that digital image was manipulated to replace the solid color background with a new background, and wherein the order servicing computer is configured to provide the customer with an on-line opportunity to order a print of the digital image that includes the customer with the new background.

40. The order servicing equipment defined in claim 38 wherein the order servicing computer is configured to provide the digital images to a processing lab in a different city than the order servicing computer for printing.